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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,225	08/10/2001	John H. Erickson	14527/05201	4650

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EXAMINER

OROPEZA, FRANCES P

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 07/31/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/927,225

Applicant(s)

ERICKSON ET AL. CS

Examiner

Frances P. Oropeza

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 8/10/01 (Initial Filing).
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5,6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1-5 and 9-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1, 4 and 11, include in the preamble the transitional phrase “having”, such that the scope of the claims is indeterminate. For purposes of this response, a closed-ended transitional phrase is assumed to be included for “having” in the wording of the Applicant’s claims.

Claim 9 is unclear because in line 5 it appears “a styllet” should be --the styllet--.

The scope of claim 10 is indefinite because the limitation in the claim refers to an apparatus rather than the method of placing the lead.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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3. Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoon (US 5484426). Yoon discloses a spinal stimulation device with a variable transverse dimension to mate with the spinal placement location (figures 14, 29 and 30; abstract; col. 3 @ 10-55; col. 5 @ 36-52; col. 6 @ 40-47; col. 9 @ 1-21; col. 10 @ 36-45).

4. Claims 1, 4, 6, 8 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Clark et al. (EP 0 215 726). Clark et al. disclose an electrode array (figure 1; page 4 @ 4-14; page 2 @ 12 – page 3 @ 3).

5. Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by King et al. (US 6161047). King et al. disclose a stimulation lead (figures 1, 2A, 10A and 10B; col. 3 @ 60-67; col. 6 @ 54-62).

6. Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Errico et al. (US 6175769). Errico et al. disclose a spinal cord electrode assembly (figures 1 and 3; col. 2 @ 56-63; col. 3 @ 41-52; col. 4 @ 46-50).

7. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Kuzma et al. (US 6522932). Kuzma et al. disclose a paddle-type electrode for spinal stimulation (figures 3, 7A and 11A; abstract; col. 2 @ 8-22 ).

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8. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Kohnen et al. (US 6249707). Kohnen et al. disclose a paddle style lead (figures 2, 3 and 6-8; col. 1 @ 7-15; col. 4 @ 64 – col. 5 @ 18).

9. Claims 1, 4, 6, 8 and 10-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Loeb (US 6112124). Loeb discloses an electrode array (figures 1, 8A and 8B).

***Abstract***

10. The abstract of the disclosure is objected to because in the first sentence, it appears “insertion made” should be --insertion is made--.

***Conclusion***

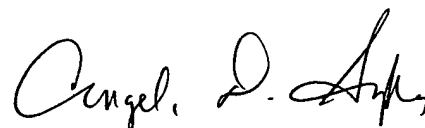
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Fran Oropeza, telephone number is (703) 605-4355. The Examiner can normally be reached on Monday – Thursday from 6 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Angela D. Sykes can be reached on (703) 308-5181. The fax phone number for the organization where this application or proceeding is assigned is (703) 306-4520 for regular communication and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist, telephone number is (703) 308-0858.

Frances P. Oropeza  
Patent Examiner  
Art Unit 3762

*FPO*  
*7/24/03*



ANGELA D. SYKES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700